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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,817	08/16/2001	Stephen M. Bull	BUL-001	3311

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EXAMINER

COBURN, CORBETT B

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Intn

<b>Office Action Summary</b>	<b>Application No.</b> 09/931,817	<b>Applicant(s)</b> BULL, STEPHEN M.	
	<b>Examiner</b> Corbett B. Coburn	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.  
4a) Of the above claim(s) 1-24 and 29-39 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) 25-28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/5/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 25-39 in the reply filed on 2 November 2005 is acknowledged. Applicant has also elected to pursue the species drawn to the cellular telephone embodiment. Should the generic claims become allowable, the other species will be rejoined.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 3 May 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the foreign language information referred to therein has not been considered.

### ***Specification***

3. The use of the trademarks DIABLO II, WARNER BROTHERS, etc. has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 27 & 28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing the clues in a cross-channel manner, does not reasonably provide enablement for solving the clues in a cross-channel manner. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Solving clues is a mental step accomplished by the player. It is not clear how this entirely mental step can be accomplished in a cross-channel manner. It is clear that the clues may be provided to the player in a cross-channel manner. Furthermore, it appears from Applicant's specification that the intent is to claim providing the clues in a cross-channel manner. For the purposes of examination, it is assumed that Applicant intended to claim providing the clues.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 26 states that, "Knowledge of the game spaces are [sic] communicated to players located in a cell zone of the game space." It is unclear what this means. There are two possibilities: (1) That the fact that the player is in a game space is communicated to the player within the cell zone of the game space. (2) That the clues are communicated to the player within the cell zone of the game space. Either interpretation appears equally plausible. For the purpose

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of examination, Examiner will assume that the second choice is correct. (Examiner will also point out that “knowledge” is singular and takes a singular verb.)

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Sporgis (US Patent Number 6,320,495).

**Claim 25:** Sporgis teaches a method of providing a game including providing one or more game spaces (Fig 4). In each game space, players are provided with clues that may be on any subject (including an advertising object). Upon solving the clue, a player proceeds from one game space to another game space. (Col 2, 50 – Col 3, 18) Sporgis states that commercial sponsors may support the game in exchange for advertising rights. (Col 3, 21-23) Thus either Sporgis inherently has at least one advertising object in each game space, or it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sporgis to have at least one advertising object in each game space in order to carry out the suggestion that commercial sponsors may support the game in exchange for advertising rights.

**Claim 26:** Knowledge of the game spaces is communicated to players located in a cell zone of the game space. The clues are provided depending on a player's location. (Col 3, 8-13)

**Claims 27 & 28:** Sporgis teaches providing the at least one clue is accomplished in a cross-channel manner using a cellular telephone. (Col 2, 1-11)

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents teach similar games: Miles et al. (US Patent Number 6,102,406), Sporgis (US Patent number 6,932,698), Seidman (US Patent Number 6,452,930), Keith (US Patent Number 6,632,142), Faris et al. (US Patent Number 6,659,861) and Faris et al. (US Patent Number 6,677,858)

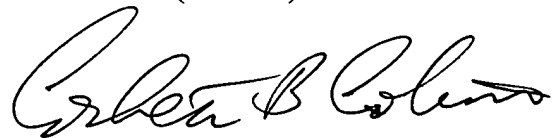
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl J. Tyler can be reached on (571) 272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Corbett B. Coburn". The signature is fluid and cursive, with the first name "Corbett" being more prominent and the last name "Coburn" following in a similar style.

Corbett B. Coburn  
Examiner  
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